

REMARKS

Applicants acknowledge the Examiner's analysis of Hooven et al. '536 (e.g., Figs. 28, 29) construing the distal ends of the instrument as extending substantially aligned with the axis of hinge 76.

However, claim 1 has been rejected under 35 U.S.C. § 102(e) as being anticipated by Hooven et al. '536, and this rejection is respectfully traversed with respect to this claim as amended herein.

Specifically, claim 1 recites “a transmural system including at least two electrodes disposed on the inner surface of the first jaw member along the recess on opposite sides thereof and adapted to selectively transfer electrical signals therebetween through the target tissue for monitoring the transmural of an ablation lesion formed therein by the ablation device disposed within the recess of the first jaw member.”

These aspects of the claimed invention are not disclosed or fairly derived from Hooven et al. '536 that merely place electrodes in one and the opposite jaws for delivering both ablative electrical energy and also measuring transmural *through* tissue grasped between the jaws.

In contrast, claim 1 specifically defines two electrodes disposed on the same one jaw along opposite sides of the recess therein for passing electrical signals between the electrodes on the one jaw (contacting one surface of ablated tissue),

for monitoring transmural of tissue caused by a separate ablation device disposed within the recess of the one jaw. This greatly facilitates using independent forms of ablative energy (from a device within the recess of one jaw) than can be delivered via electrodes positioned in opposite grasping jaws, as disclosed by Hooven et al. '536. It is therefore respectfully submitted that claim 1 is not anticipated by Hooven et al. '536, but instead is patentably distinguishable over the prior art.

Rejected claims 18-20 have been rejected without prejudice.

Claim 1 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Truckai et al. '4851 in view of Hooven et al. '536. This rejection is respectfully traversed with respect to this claim as amended herein.

This claim is specifically limited to “a transmural system including at least two electrodes disposed on the inner surface of the first jaw member along the recess on opposite sides thereof and adapted to selectively transfer electrical signals therebetween through the target tissue for monitoring the transmural of an ablation lesion formed therein by the ablation device disposed within the recess of the first jaw member.” These aspects of the claimed are not disclosed or fairly derived from the cited references considered either alone or in the combination proposed by the Examiner.

Specifically, the deficiency in the disclosure of Hooven et al. '536 is discussed in the above Remarks, and Truckai et al. '4851, relies upon electrodes 56 to deliver ablative energy at “high RF energy densities in engaged tissue” (pg. 5, right col., para. 0054), and not for “monitoring the transmural of an ablation lesion formed therein by the ablation device” (as separate from the electrodes), in the manner as claimed by Applicants. Additionally, the recess in the jaws of Truckai et al. '4851 houses a cutting wire 40, 50 that is not an ablation device. Thus, merely combining these references as proposed by the Examiner would impermissibly alter the operational purpose or function of the references and would nevertheless fail to establish even a *prima facie* basis, including *all* recited elements in the structure, from which a proper determination of obviousness may be formed. It is therefore respectfully submitted that amended claim 1 is now patentably distinguishable over the cited art.

The Examiner is kindly requested to contact the undersigned attorney for the Applicants regarding any remaining issue that may expedite favorable disposition of this application.

Respectfully submitted,
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